



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,054	11/14/2001	Aref Ben Ahmed Jallouli	ESSR:058US/MBW	4850

7590 11/08/2006

FULBRIGHT & JAWORSKI L.L.P.
A REGISTERED LIMITED LIABILITY PARTNERSHIP
SUITE 2400
600 CONGRESS AVENUE
AUSTIN, TX 78701

EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
----------	--------------

1711

DATE MAILED: 11/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/992,054	Applicant(s) JALLOULI ET AL.	
	Examiner Rabon Sergeant	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-24 and 28-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-24, 28-30, 33-35, 38 and 40-43 is/are rejected.
- 7) ☒ Claim(s) 31, 32, 36, 37 and 39 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1711

1. Claims 28 and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The first prepolymer of claim 28 renders the claim indefinite and fails to further limit claim 22, because the lower end of the average molecular weight range cannot be obtained when the values of x and y are 1 or less; furthermore, such compounds would not be the required polysulfide.

The subject matter of claim 41 fails to further limit claim 22, because the "at least one S atom in its chain" limitation fails to satisfy the requirement that the dithiol prepolymer must be a polysulfide.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 22-24, 28-30, 33-35, 38, and 40-42 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 01/36508.

The reference discloses an optical polymerizate, suitable for the production of optical lens material having a refractive index that exceeds that claimed, wherein the polymerizate is produced from an isocyanate functional prepolymer and an aromatic primary diamine, wherein the reactants contain sulfur atoms. See abstract, pages 3-23, and claim 7. Furthermore, with respect to claim 28, there is no requirement that x or y not be zero; therefore, when x is zero, the resulting prepolymer would be satisfied by an oligomer of 2,2'-thiodiethanethiol. See claim 7.

Art Unit: 1711

4. Claims 22-24, 28-30, 33-35, 38, and 40-43 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 01/36507.

The reference discloses an optical polymerizate, suitable for the production of optical lens material having a refractive index that exceeds that claimed, wherein the polymerizate is produced from an isocyanate functional prepolymer and an aromatic primary diamine, wherein the reactants contain sulfur atoms. See abstract, pages 3-24, and claim 7. Furthermore, with respect to claim 28, there is no requirement that x or y not be zero; therefore, when x is zero, the resulting prepolymer would be satisfied by an oligomer of 2,2'-thiodiethanethiol. See claim 7.


5. Applicants' response, filed September 1, 2006, to the prior art rejections has been carefully considered; however, the response is insufficient to overcome the rejections.

Applicants' argued definition of prepolymer allows for the prepolymer to be an oligomer, and it is noted that claim 7 specifically allows for oligomers of the specified thiols, and the position is taken that such oligomers would inherently encompass polysulfides. Applicants have not conclusively established that the disclosed oligomers are not within or encompassed by the argued prepolymers.

6. Claims 31, 32, 36, 37, and 39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent
November 1, 2006


RABON SERGENT
PRIMARY EXAMINER